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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/530,570    05/03/00    RITTER    R    268771

000909  
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TM02/0921

EXAMINER

MCALLISTER, S

ART UNIT

PAPER NUMBER

2167

DATE MAILED:

09/21/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/530,570**

Applicant(s)  
**Ritter**

Examiner  
**Steven B. McAllister**

Art Unit  
**2167**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 3, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because the block diagrams have no headings, only reference numbers. Correction is required.

### *Specification*

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
3. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).
4. The disclosure is objected to because of the following informalities: the specification should be modified to correspond to standard U.S. practice, adding headings, etc..

Appropriate correction is required.

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***Claim Objections***

5. Claims 27 and 28 are objected to because of the following informalities: the reference number for the fee table is 1001, not 1000. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-30, the phrase "and/or" renders the claim indefinite because it is unclear what limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 18 is indefinite because the preamble recites the subcombination of a SIM card, but the body of the claim recites elements ("another system") of the combination of the overall billing system. It is unclear whether the applicant intended to claim the combination or subcombination. In examining the claim, it was read as subcombination. Correction is required.

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Claim 22 is unclear because it is unclear whether it intended to mean that the resource is outside the card or whether the resource has simply been procured from an outside provider at some point in time by either the card maker or user. In examining the claim, the latter was assumed. Additionally, that the "billed for amount corresponds to a service fee" is a part of the overall method and system, but a part of the card itself.

Claim 25 is indefinite because it appears it recites both elements of an apparatus claim and a positive method step ("to transmit"). If it is assumed that the claim intends to recite "means to transmit", the claim is also indefinite because the preamble recites the subcombination of a SIM card, but the body of the claim recites elements ("means to transmit") of the combination of the overall billing system. It is unclear whether the applicant intended to claim the combination or subcombination. In examining the claim, it was read as subcombination. Correction is required. Lack of an art rejection should not be interpreted as an indication of allowability because application of prior art would require substantial speculation by the examiner.

8. Claim 1 provides for the use of a SIM card, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that claim 1 does not positively claim any steps of a method. If the text is interpreted as claiming steps, the process is not enabled by the disclosure because it claims billing the user before the counter is incremented, which is the basis for billing. One of ordinary skill in the art would not be able to make or use the invention of claim 1 without undue experimentation.

11. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 19 recites a system the counts and bills within the SIM. While the specification discloses

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the counting function being within the SIM, it discloses the billing taking place over the entire billing system. One of ordinary skill in the art would not be able to make or use the invention as claimed without undue experimentation.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

13. Claims 16, 18, 20, 21, 24, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Croughwell et al (5,966,654).

Croughwell et al show all elements of the claim including counters for which increment when they are updated (Fig. 4B).

As to claim 18, it is noted that the external interface could be used to use the card in another system.

As to claims 20 and 21, it is noted that the counter can be updated based on discrete events (such as calls) or talk time.

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*Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croughwell et al.

Croughwell et al shows all elements of the claim except a contactless interface. However, contactless interfaces are old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the SIM card of Croughwell et al by adding a contactless interface to allow the card to be used in additional environments.

Croughwell et al show all elements of the claim except that at least one resource having been gotten from an outside provider. However, it is old and well known in the art for a maker of an item to buy hardware or software and integrate it into his system. It would have been obvious to one of ordinary skill in the art to have gotten at least one resource from an outside provider in order to minimize development work.

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Croughwell et al in view of Martineau (WO 97/40616).

Croughwell et al show all elements of the claim except updating the fee table over the air. Martineau shows such updating. It would have been obvious to one of ordinary skill in the art to



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modify the apparatus of Croughwell et al to allow such updating in order to keep fees updated while maximizing convenience for customers (they don't have to come in to get the card updated).

*Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


McGregor et al (5,577,100) show a phone with internal accounting.

Croughwell et al (5,966,654) show a phone as discussed above.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.

  
Steven B. McAllister

September 19, 2001

  
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